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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/066,935
Filing Date: February 04, 2002
Appellant(s): MEHAWEJ, FOUAD D.

Allison Johnson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/10/06 appealing from the Office action mailed 2/10/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,086,620	Chmielewski	5-2000
5,788,684	Abuto et al.	8-1998
20030105441	Chmielewski	6-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 102/103

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 2-10, 18-20, 26-30, 32-34, 37, 44, 45, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by or in the alternative under U.S.C. 103(a) as being unpatentable over Chmielewski USPN 6068620.

As to claims 2-5, 37, 44, 45, and 47, Chmielewski discloses a an absorbent article, such as a disposable diaper, feminine hygiene product, or adult incontinence product (col. 4, lines 55-63) having a core 34 that comprises a composite 340 comprising:

superabsorbent polymer; and a high loft nonwoven web impregnated with the superabsorbent polymer, the composite comprising from 10% by weight to about 90% by weight superabsorbent polymer (col. 8, lines 12-14; col. 11, lines 9-28, 47-67; col. 14, lines 27-34). The limitation of the superabsorbent polymer having been formed in situ is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious

from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claims 6-10, Chmielewski discloses a basis weight of the nonwoven web 340 in a range from 50-300 gsm, which is includes the claimed ranges (col. 12, lines 43-50).

As to claims 18-20, see Chmielewski col. 17, lines 30-40.

As to claim 26, Chmielewski discloses the diaper further comprises a topsheet 30, an acquisition layer 344, a cellulose fiber layer 340b, 340c, and an impermeable layer 32.

As to claim 27, Chmielewski discloses the core further comprises cellulose fibers (layer 340c Figure 3 and col. 11, lines 42-44) the diaper further comprising an acquisition layer 344, and the cellulose fiber are disposed between the acquisition layer 344 and the composite 340 (Figure 3).

As to claim 28, Chmielewski discloses the disposable diaper further comprises an acquisition layer 344 and an impermeable layer 32. The core 34 is disposed between the acquisition layer 344 and the impermeable layer 32 (Figure 3).

As to claim 29, Chmielewski discloses the disposable diaper further comprises a second nonwoven web 30 (col. 5, lines 61-66) and an acquisition layer 344. The acquisition layer 344 is disposed between the core 34 and the second nonwoven web 30 (Figure 3).

As to claims 30 and 32, see Chmielewski col. 1, lines 27-44.

As to claim 33, Chmielewski discloses the superabsorbent polymer is enclosed within a matrix of the high loft web 340a. The web 340a is at least partially enveloped in webs 340c and 340b. Because the web 340a is encased in the tissue layers 340c and 340b, it is reasonable to conclude the SAP would remain in the web when contacted with water and Chmielewski teaches leakage of the SAP is obstructed by the wrapping layers (col. 8, line 65 through col. 9, line 11).

As to claim 34, Chmielewski discloses the core further comprises cellulose fibers 342, the composite 340 is disposed in regions on the cellulose fibers (Figures 2 and 3).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 11-17, 21-25, 31, 38, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chmielewski USPN 6068620.

As to claims 11-14, 38 and 46, Chmielewski discloses a an absorbent article, such as a disposable diaper, feminine hygiene product, or adult incontinence product (col. 4, lines 55-63) having a core 34 that comprises a composite 340 comprising:

superabsorbent polymer; and a high loft nonwoven web impregnated with the superabsorbent polymer, the composite comprising from 10% by weight to about 90% by weight superabsorbent polymer (col. 8, lines 12-14; col. 11, lines 9-28, 47-67; col. 14, lines 27-34). The limitation of the superabsorbent polymer having been formed in situ is directed to a process of making the article. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

Chmielewski discloses the present invention substantially as claimed. However, Chmielewski does not disclose a density in the claimed range. Although Chmielewski does not give the claimed density value, the applicant fails to disclose that a density less than 0.01 g/cm^3 is such a critical value or gives unexpected results so to exclude a

higher density. In the absence of any new or unexpected results, discovering the optimum or workable ranges involves only routine skill in the art.

As to claims 15-17, Chmielewski teaches the present invention substantially as claimed except Chmielewski does not teach the composite exhibits a saline absorption capacity under a load of 0.3 psi of at least 10-20 g 0.9% saline/g composite. However, Chmielewski an absorbency under a load of 0.5 psi of at least 20 g/g SAP in the composite. The composite has the same properties (liquid absorbency) and is used in the same environment as applicant's outer cover (absorbent articles). Therefore, the general conditions of the claimed invention are present in the prior art. Even though Chmielewski does not disclose the specific test and test results, applicant has not disclosed the claimed absorbency value is critical or more effective at liquid uptake and storage than any other level of absorbency, that may be measured by a different absorbency test. The claims are structural claims and the composite of Chmielewski apart from how it is tested, results in a liquid absorbent structure. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the composite with the claimed absorbency value of the present invention, since where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, In re Aller et al. 105 USPQ 233.

As to claims 21-25, regarding the tensile strength and the examiner's interpretation of the test and performance characteristics of the instant apparatus claims, when the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald,* 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980). In the present case, the reference has met the structural requirements of claim 1. Additionally, Chmielewski discloses bonding the fibers within the web to provide for a high wet strength (col. 13, lines 14-19). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the composite with the claimed tensile strength values of the present invention, since where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, In re Aller et al. 105 USPQ 233.

As to claim 31, Chmielewski does not specifically disclose the claimed carboxylic acid monomer. However, it is old and well known in the art, and therefore obvious, to use the claimed carboxylic acids in superabsorbent polymers. For example, Abuto et al.

USPN 5788684 discloses maleic anhydride polymers for use as hydrogel polymers (col. 4, line 67 through col. 5, line 11).

5. Claim 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chmielewski in view of Abuto et al. USPN 5788684. Chmielewski discloses the present invention substantially as claimed. However, Chmielewski does not disclose the core comprises a plurality of strips of the composite. Abuto discloses a liquid-absorbing article having discrete areas of superabsorbent for the benefit of allowing room for the superabsorbent to expand and thus, more effectively utilizing the superabsorbent (Abstract and col. 2, lines 9-17). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of Chmielewski to form the core in a plurality of strips for the benefits disclosed in Abuto.

6. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chmielewski USPN 6068620 in view of Chmielewski US 2003/0105441. '620 discloses the claimed invention except that Chmielewski instead of meltblown fibers shows airlaid fibers (Abstract). '441 shown that meltblown webs are an equivalent structure known in the art (paragraph 41). Therefore, because these two webs are art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute meltblown fibers for airlaid fibers.

(10) Response to Argument

Applicant's arguments filed 7/10/06 have been fully considered but they are not persuasive. Applicant repeats the argument that Chmielewski does not disclose a core that includes a nonwoven web that includes a superabsorbent polymer or a high loft nonwoven. As previously stated by the Examiner, Applicant is directed to col. 8, lines 36-67;col. 10, lines 36-60; col. 11, line through col. 12, line 58 where Chmielewski teaches a core of SAP and fibrous additives, such as polyester and bicomponent fibers, which are known in the art as resilient fibers that add bulk and loft. Additionally, the present invention on page 8, lines 1-7 describes the high loft web as containing the same materials as those taught in Chmielewski, col. 11, line 47 through col. 12, line 9. Applicant repeats the argument that Chmielewski does not disclose a web where the superabsorbent is formed *in situ*, and argues this creates a structural difference in that the superabsorbent formed *in situ* is present throughout the web. Chmielewski teaches compositions of up to 80% SAP. At this high concentration of SAP, it is inevitable that the SAP is present throughout the web. Applicant argues the limitation directed to the formation of the superabsorbent in the web imparts a structural difference to the web whereas the superabsorbent polymer precursor composition is in contact, and in interstices between the fibers. How the SAP is applied does not patentability distinguish the *structure* over the prior art. There is no evidence and/or comparison of any unexpected result in terms of the superabsorbent formed *in situ* compared to the SAP present throughout the web as disclosed in the prior art. The rejection has been

made in the sense of *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted), which states that when the product is claimed the patentability is defined only by the product per se, not by the process of its making and the burden is shifted to Applicant to show that the process of the prior art produces a different product. This should be presented by the factual evidence, and in the instant case the Applicant failed to show a valid side-by-side comparison between their product and the product disclosed by the Chmielewski reference wherein the only difference is the process of their making as per *In re Dunn*, 349 F. 2d 433, 146 USPQ 489 (CCPA 1965).

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Jacqueline F. Stephens
Primary Examiner, Art Unit 3761

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

Conferees:

Angela Sykes
Supervisory Primary Examiner
Art Unit 3762

Tatyana Zalukaeva
Supervisory Primary Examiner
Art Unit 3761

TATYANA ZALUKAEVA
SUPERVISORY PRIMARY EXAMINER